UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,494	07/29/2003	James L. Kroening	P1907US00	7438

24333	7590	04/28/2006

GATEWAY, INC.
ATTN: Patent Attorney
610 GATEWAY DRIVE
MAIL DROP Y-04
N. SIOUX CITY, SD 57049

EXAMINER
GENTRY, DAVID G

ART UNIT	PAPER NUMBER
2114	

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/629,494	KROENING ET AL.
	Examiner	Art Unit	
	David G. Gentry	2114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 July 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-16</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer readable medium is defined as pertaining to carrier waves on page 3, lines 13-14 or the specification. Carrier waves are non-statutory subject matter.

Claim Rejections - 35 USC § 102

Claims 1, 4, 8, 14, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Burks (U.S. Publication No. 2005/0010616).

As per claims 1, 8, and 14, Burks discloses a method of restoring a system, the method comprising:

receiving a request for a new disk drive for an identified customer computer system (paragraph 21, lines 13-16; Note: if a replacement drive is being prepared, it is understood that there has been a request for one);

retrieving an extended parts list for the customer computer system (paragraph 21, lines 16-19; lines 27-31; Note: the replacement drive contains information to allow the computer to locally download the needed files which represents the extended parts list);

providing a restore program on the new disk drive (paragraph 21, lines 16-19;

Note: if the restoration is done by locally downloading, there must be a program used to

implement this procedure); and

storing the extended parts list on the disk drive for use by the restore program in

restoring the computer system (paragraph 21, lines 16-19).

As per claim 4, Burks discloses a method wherein the restore program is an

image of a system recovery compact disk program (paragraph 21, lines 6-13).

As per claim 16, Burks discloses a computer readable medium wherein the new

disk drive also comprises operating system and application software for installing on the

computer system consistent with the extended parts list (paragraph 21, lines 19-21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 6, 7, 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks in view of McBride et al. (U.S. Publication No. 2002/0083367).

Burks is relied upon for reasons stated in the previous section.

As per claim 2, Burks fails to disclose the new disk drive in the same condition as it was when it originally left the factory, although he does disclose shipping the new disk drive (paragraph 21, lines 13-16).

McBride discloses a method further comprising a computer system that is restored to the same state it was in when it originally left the factory (paragraph 12).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by McBride in the method described by Burks. It would have been obvious because it would allow the new disk drive to keep its primary functionality (McBride: paragraph 13).

As per claim 3, Burks fails to disclose the restore program stored in the host protected area.

McBride discloses a method wherein the restore program is stored on the new disk drive in a host protected area of the disk drive (paragraph 30).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by McBride in the method described by Burks. It would have been obvious because it prevents accidental access or changes to the program (McBride: paragraph 30).

As per claim 6, Burks discloses a system that creates a replacement disk drive for a computer, the system comprising:

a replacement fulfillment processor that receives a replacement order, obtains an extended parts list and a recovery program (paragraph 21, lines 13-19; lines 27-31; Note: the extended parts list is the list used to locally download the needed files); and

a replacement hard drive creator that obtains a suitable disk drive and stores the recovery program and the extended parts list onto the suitable disk drive (paragraph 21, lines 13-19; Note: it is understood that a replacement hard drive creator must be used to produce said replacement hard drive).

Burks fails to disclose the new disk drive in the same condition as it was when it originally left the factory, although he does disclose shipping the new disk drive (paragraph 21, lines 13-16).

McBride discloses a method further comprising a computer system that is restored to the same state it was in when it originally left the factory (paragraph 12).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by McBride in the method described by Burks. It would have been obvious because it would allow the new disk drive to keep its primary functionality (McBride: paragraph 13).

As per claim 7, McBride discloses a method wherein the restore program is stored on the new disk drive in a host protected area of the disk drive (paragraph 30).

As per claim 9, Burks discloses a method of restoring a computer system, the method comprising:

installing a replacement hard disk drive into the computer system (paragraph 21, lines 13-19);

powering up the system (paragraph 21, lines 13-19; Note: it is understood that the computer system must be powered up to complete this process);

executing a restore script (paragraph 21, lines 13-19; Note: if the restoration is done by locally downloading, there must be a program used to implement this · procedure);

using an extended parts list on the replacement hard disk drive to select operating system drivers to creating a restored operating system (paragraph 21, lines 16-19; lines 27-31; Note: the replacement drive contains information to allow the computer to locally download the needed files which represents the extended parts list).

Burks fails to disclose rebooting into the restored operating system.

McBride discloses a method of restoring a computer system, the method comprising:

rebooting into the newly restored operating system (paragraph 73).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by McBride in the method described by Burks. It would have been obvious because it is a well-known method used to complete restoration back to a known state (McBride: paragraph 73).

As per claim 10, McBride discloses a method wherein the restore script is stored on the hard disk drive in a host protected area (paragraph 30).

As per claim 11, McBride discloses a method wherein after the operating system is restored and prior to rebooting into the newly restored operating system, a max hard drive address is set to ensure rebooting into the newly restored operating system

(paragraph 60; figure 4A, items 415,420,425,430).

As per claim 12, Burks discloses a method wherein the replacement hard drive comprises operating system code and application code, and wherein the restore script uses such code in conjunction with the extended parts list to restore the computer system (paragraph 21, lines 13-21).

Burks fails to disclose restoring the computer system back to the state it was in when it was originally manufactured.

McBride discloses restoring the computer system to the state it was in when it was originally manufactured (paragraph 12).

As per claim 13, Burks discloses a method of restoring a computer system, upon installation of a replacement hard disk drive into the computer system and powering up the system, the method comprising:

executing a restore script (paragraph 21, lines 13-19; Note: if the restoration is done by locally downloading, there must be a program used to implement this procedure);

using an extended parts list on the replacement hard disk drive to select operating system drivers to creating a restored operating system (paragraph 21, lines 16-19; lines 27-31; Note: the replacement drive contains information to allow the computer to locally download the needed files which represents the extended parts list).

Burks fails to disclose rebooting the system.

McBride discloses a method for restoring a computer system, comprising:

rebooting into the newly restored operating system (paragraph 73).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by McBride in the method described by Burks. It would have been obvious because it is a well-known method used to complete restoration back to a known state (McBride: paragraph 73).

As per claim 15, Burks fails to disclose the restore program stored in the host protected area.

McBride discloses a computer readable medium wherein the restore program is stored on the new disk drive in a host protected area of the disk drive (paragraph 30).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by McBride in the method described by Burks. It would have been obvious because it prevents accidental access or changes to the program (McBride: paragraph 30).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burks in view of Purcell (U.S. Patent No. 6,081,789).

Burks is relied upon for reasons stated in the previous section.

Burks fails to disclose a hard drive disk inventory.

Purcell discloses searching an inventory for the desired product (column 4, lines 2-20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the method described by Purcell in the method described

by Burks. It would have been obvious because it is allows the matching of buyers and sellers to products (column 1, lines 27-35).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Gentry whose telephone number is (571) 272-2570. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571) 272-3644. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCOTT BADERMAN
SUPERVISORY PATENT EXAMINER